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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10 024,639	12 18 2001	Gregory J. Athas	MM-060.03	3186

25784 7590 06 02 2003

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EXAMINER

MOORE, KARLA A

ART UNIT	PAPER NUMBER
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1763

DATE MAILED: 06 02 2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,639

Applicant(s)

ATHAS ET AL.

Examiner

Karla Moore

Art Unit

1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 18 is/are pending in the application
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,354,438 to Lee et al.

3. Lee et al. disclose an apparatus (70) for shaping a pole-tip assembly of a recording transducer with a focused particle beam in Figure 7, said apparatus comprising: a platform (86) for receiving a substrate such as a multi-layer device (90, column 9, rows 49-52) and for disposing said multi-layer device for interaction with said focused particle beam (80). The apparatus is capable of first selectively imaging step on a multi-layer substrate on a geometrical surface extending transversely to the layers of the substrate (column 12, rows 56-58). The system is further capable of a second selective imaging step (column 13, rows 7-10) based on information obtained during the first selective imaging step.

4. The apparatus includes means for scanning (79, column 11, rows 5-9 and column 12, rows 51-63) said focused particle beam over said geometrical surface at a selected section as detailed above; means for generating a first image signal (column 10, rows 46-50) responsive to interaction with the first geometrical surface; means for analyzing the first image signal (column 10, rows 50-57) to determine a location on said first geometric surface; means capable of directing (column 10, rows 63-67), responsive to said determined location, said focused particle beam to interact with a second structural element without substantially interacting with a second structural element; means capable of generating (column 10, rows 46-50) a second image signal responsive to interaction of said focused particle beam with said

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second structural element; and processor means (column 10, rows 42-46) responsive to said second imaging signal and capable of generating a milling signal representative of an instruction for applying said focused particle beam to a selected portion of said second structural element for milling a portion of said second structural element.

5. With respect to claim 2, said means for generating said second image further includes: means for generating, responsive to a second image signal, a coordinate signal representative of an instruction for applying said focused particle beam (column 5, rows 56-64).

6. With respect to claim 3, said means for generating a first image signal include a source of a focused particle beam (column 3, rows 30-35).

7. With respect to claim 4, said means for generating a first image signal and means for generating a second image signal include a camera element. Although not explicitly disclosed in on the present prior art patent, the use of a camera is disclosed in a parent patent (U.S. Patent No. 5,916,424) which was incorporated by reference (column 1, rows 6-11 of '438 and column 3, rows 46-49 of the '424).

8. With respect to claim 5, the apparatus further includes charge neutralization means capable of neutralizing a static electric charge on said recording transducer (column 9, rows 46-52).

9. With respect to claim 18, although worded differently, claims 1 and 18 appear to include the same structural limitations, which are detailed above.

10. Examiner notes that the courts have ruled that inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. In re Young, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karla Moore whose telephone number is 703.305.3142. The examiner can normally be reached on Monday-Friday, 8:30am-5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on 703.308.1633. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9310 for regular communications and 703.872.9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.

km
May 29, 2003


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TECHNICAL SERVICES